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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,239	02/15/2000	Bruce L. Davis	60114	7614

23735 7590 09/12/2002

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

PATEL, JAYANTI K

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 09/12/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,239

Applicant(s)

DAVIS ET AL.

Examiner

Jayanti K. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-15,17-19,21 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-15,17-19 and 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10-16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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PART III DETAILED ACTION

Response to Amendment / Arguments

1. Applicant's arguments filed April 25, 2002 and June 21, 2002 have been considered but are deemed to be moot in view of the new grounds of rejection necessitated by the applicant's amendment.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 3-15, 17-19, 21, 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsay et al. (US. 5,502,576) in view of Houser et al. (US. 5,606,609) further in view of Moskowitz et al. (US. 5,687,236).

Regarding claims 3, 5, 8, 9, 11, 13, and 19, Ramsay discloses system for transmission, storage and retrieval of documents in an electronic domain comprising the steps of:

sensing a media object in human-perceptible form (column 4, lines 29-45 and column 16, lines 29-35), and converting same to electronic form (column 25, lines 35-45); by reference to the object identification data (including watermark data), identifying a set of data stored in a repository at a remote site (column 26, lines 35-45 and column 8, lines 35-50), the set of data comprising at least one media content file; and sending the set of data from the repository (column 26, line 46 through column 27, line 20) and a method in which content file represents the same media object as originally sensed but represented with higher fidelity or accuracy (column 12, lines 1-27) and a variety of media objects including a graphic printed on the page (column 5, line 57 through column 6, line 25).

The system of Ramsay deals with security related features associated with the document (column 42, lines 11-30). However, Ramsay is silent about the specific details regarding the step of decoding object identifier and steganographically encoding the data content.

In the same field of endeavor, however, Houser discloses an electronic document verification system comprising the step of decoding object identification data

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from the electronic form (column 20, lines 39-45). As to the specific limitations of transmitting certain selected part of the object identification by select group devices is merely design choice and routinely performed in a typical multimedia and internet system (column 1, line 25 through column 2, line 60) including a selected portion of the data of a object (for example digital signature, column 16, lines 25-50). Additionally, Moskowitz discloses a steganographic encoding system comprising the step of steganographically encoding watermark data (column 5, lines 25-40)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the step of encoding and decoding object identification data as taught by Moskowitz and Houser in the electronic document processing system of Ramsay because the system of Houser provides Ramsay with an electronic document verification system having a security information assembler that, responsive to a users' request assembles security information into a predetermined format. Document processing system of Houser and Ramsay are well known in the document processing art as evidenced by numerous art of record of the instant application.

As to remaining claims 4, 6-7, 10, 12, 14-15, 17-18, 21 and 24-32, Ramsay discloses a conventional electronic document processing system which performs various document processing functions using conventional processors, storage devices, data capture and encoding devices, output devices such as printers and displays (see figure 2, element 10) at both remote and local sites of interconnected network. The claimed limitations of performing the recited steps at remote or local devices are merely

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various design preferences and are routinely performed in parallel, synchronously or asynchronously by a variety of document processing devices (see Ramsay, column 15, line 5 through column 20, line 67, Moskowitz, column 1, line 64 through column 2, line 65). Additionally, Houser discloses standard data communication protocols to transmit or receive data with specific instructions in a typical data communication network using LAN, WAN and ETHERNET protocols (column 8, line 40 through column 9, line 20).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayanti K. Patel whose telephone number is (703) 308-7728. The examiner can normally be reached on Monday-Friday (7:30-4:30), alternate Fridays off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5397 for regular communications and (703) 306-5406 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Jayanti K. Patel
Primary Examiner

JKP
September 10, 2002